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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/472,197	12/27/99	GARDENSWARTZ	W 7791-0092-25
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EXAMINER

HAYES, J

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/472,197

Applicant(s)

GARDENSWARTZ ET AL.

Examiner

John W Hayes

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) 1-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 85-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 2161

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed 27 December 1999 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. In this case, a copy of the non-patent literature was not provided and thus, the IDS has been placed in the application file, but the non-patent references referred to therein have not been considered.

### *Drawings/Specification*

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

Page 8, line 5 – telephone (11) is not included in the drawings

Page 11, line 9 – telephone (11) is not included in the drawings

Pages 12-13 and 19 – reference numbers listed in the specification do not correspond to the reference numbers in Figure 3.

Correction is required.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 85-90 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims, as presently claimed and best understood were considered in light of the new "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory.

Discussion of the analysis of the claims under the guidelines follows.

Art Unit: 2161

As per claims 85-90, the claims are directed to a memory comprising a data structure for storing information. The stored information is deemed to be descriptive data that cannot exhibit any functional interrelationship with the way in which computing processes are performed and does not constitute a statutory process, machine, manufacture or composition of matter. When non-functional descriptive data is recorded on some computer-readable medium, it is not structurally and functionally interrelated to the medium but is merely carried by the medium. Thus, claims 85-90 are deemed to be non-statutory.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claim 85 is rejected under 35 U.S.C. 102(e) as being anticipated by *Scroggie et al*, U.S. Patent No. 5,970,469.

As per claim 85, *Scroggie et al* disclose a database for storing information for delivering a targeted advertisement, comprising a data structure including a field for storing a first identifier corresponding to a first computer associated with a consumer in the form of an e-mail address (Col. 9, lines 29-40; Col. 12 line 53-Col. 13 line 23) and a field for storing a second identifier associated with the first identifier and corresponding to an observed offline purchase history of the consumer, the purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired (Col. 4, lines 33-47; Col. 12, lines 8-36).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2161

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, U.S. Patent No. 5,970,469 in view of *Jermyn*, U.S. Patent No. 6,026,370.

As per claim 87, *Scroggie et al* disclose a field for storing a first identifier corresponding to a first computer and associated with an observed offline purchase history of a consumer, the purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired (Col. 12 line 8-Col. 13 line 23). *Scroggie et al* fails to disclose a field for specifically storing a purchase behavior classification based on the purchase history. *Jermyn* discloses a technique for customizing purchase incentives for selected consumer households based on the detailed purchasing history and the consumer profile or classification also based on the purchasing history (Col. 2, lines 16-22 and 49-54; Col. 7, lines 20-30 and 40-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include a consumer classification in the database taught by *Scroggie et al* so that consumers could be targeted with specific incentives based on their associated category as suggested by *Jermyn* (Col. 2, lines 15-20 and 49-54). This would provide an advantage and benefit to the consumer in that they would be presented incentives that they would most likely be interested in.

9. Claims 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, U.S. Patent No. 5,970,469 in view of *Csaszar et al*, U.S. Patent No. 5,970,124.

As per claims 89-90, *Scroggie et al* disclose a database for storing ID numbers corresponding to customers (Col. 12, lines 8-25) and targeting purchase incentives to specific customers based upon the observed offline purchase history of the customer, the purchase history including information of a purchase of the customer collected at a point of sale when the purchase transpired (Col. 12 line 43-Col. 13 line 25). *Scroggie et al*, however, fail to specifically disclose an identifier corresponding to the targeted interactive voice response message. *Csaszar et al* disclose a database containing attributes of a consumer and targeted messages that an interactive voice response system can deliver to a consumer

Art Unit: 2161

based on the consumer attributes (Abstract; Col. 1 line 61-Col. 2 line 7, Col. 2, lines 18-25 and Col. 2 line 51-Col. 3 line 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the database of *Scroggie et al* and include the capability to store identifiers for targeted messages and deliver these messages via an interactive voice response system to the consumer as an alternate means to present targeted advertisements to consumers who may not have access to a computer. *Csaszar et al* also provides motivation by indicating that an advantage of interactive voice response systems is that they can deliver information that consumers desire at any time and at low cost (Col. 2, lines 35-37).

10. Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, U.S. Patent No. 5,970,469 in view of *Laor*, U.S. Patent No. 6,076,069.

As per claim 86, *Scroggie et al* further disclose wherein the second identifier comprises a shopper card identification code of the consumer (Col. 4, lines 33-47; Col. 12, lines 25-35). *Scroggie et al* further discloses a first identifier corresponding to a first computer associated with a consumer by using an e-mail address identifier (Col. 9, lines 29-40; Col. 12 line 53-Col. 13 line 23) however, fails to specifically disclose that the first identifier could be a cookie number. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines 23-40). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies are well known for providing this type of identification information.

11. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, U.S. Patent No. 5,970,469 and *Jermyn*, U.S. Patent No. 6,026,370 as applied to claim 87 above, and further in view of *Laor*, U.S. Patent No. 6,076,069.

Art Unit: 2161

As per claim 88, *Scroggie et al* further discloses a first identifier corresponding to a first computer associated with a consumer by using an e-mail address identifier (Col. 9, lines 29-40; Col. 12 line 53-Col. 13 line 23) however, fails to specifically disclose that the first identifier could be a cookie number. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines 23-40). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies are well known for providing this type of identification information.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Weinblatt discloses a technique for correlating purchasing behavior of a consumer to advertisements
- Golden et al disclose an interactive marketing network using electronic certificates and monitors redemption of consumer certificates however does not disclose an identifier corresponding to a consumer's computer
- Powell [5,806,044] disclose a method and system for distributing coupons through a computer network wherein advertisements/coupons are e-mailed to customers and wherein customers possess a shopper card, however, purchases at a POS device are not monitored
- O'Brien et al disclose an apparatus for selective distribution of coupons based on prior customer behavior and target distribution of coupons at the checkout counter, however, does not teach transmitting coupons to customers via a customer's computer
- Jovicic et al disclose an electronic coupon communication system and teaches the storage of both a customer ID and user's E-Mail address for sending electronic coupons to customers. Also teaches the storage of redemption of coupons by each customer

Art Unit: 2161

- Day et al disclose a system for offering targeted discounts to consumers and teach the tracking of customer purchases via the use of a shopper's card, customer IDs, targeted ads based on shopping behavior via an in store kiosk
- Engel et al disclose an electronic coupon distribution system for distributing electronic coupons to customers via their computer and the system may be used to obtain additional information about the customer for future marketing purposes
- Ono et al disclose a system for sales promotions based on the purchase history of consumers
- Anderson et al disclose a system for analyzing consumer purchasing information based on product and consumer clustering relationships wherein consumers are organized into clusters based on common consumer demographics and other characteristics
- Kepecs discloses a system for distributing and reconciling electronic coupons and teaches that coupons are distributed to consumers through the Internet and wherein an account is maintained for consumers using a unique key such as is used in shopper cards
- Scroggie et al [6,014,634] disclose a system and method for providing shopping aids and incentives to consumers through a computer network and further teaches the use of personalized web pages for consumers for transmitting the incentives based on consumer shopping history
- Levelle et al [WO 98/21713] disclose a system for tracking consumer purchases via a POS device and based on consumer profile information, determines a specific discount for each consumer.



Art Unit: 2161

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

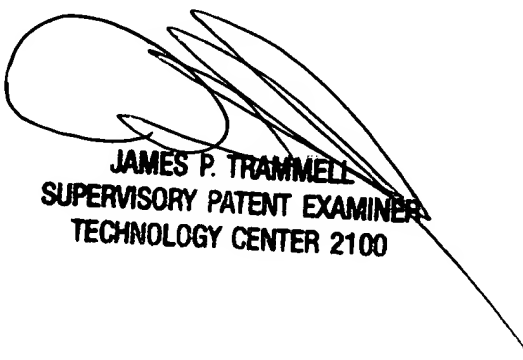
The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 308-9051 or 9052 (for formal communications intended for entry).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JWH

20 December 2000



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